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Supreme Court of the United States

OCTOBER TERM, 1987

KYOCERA INTERNATIONAL, INC.
and KYOTO CERAMIC CO., LTD.,

Petitioners,

vs.

KENNECOTT CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITIONERS' REPLY BRIEF

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Petitioners, Kyocera International, Inc. and Kyoto Ceramic Co., Ltd. (collectively, "Kyocera"), respectfully submit this Reply Brief in support of their Petition for a Writ of Certiorari filed March 21, 1988 ("Petition"), and in reply to the Brief in Opposition ("Opposition") filed on behalf of respondent, Kennecott Corporation ("Kennecott").[1]

REPLY ARGUMENT

A. There Is No "Express" Or "Inherent" Description Of An Equiaxed Microstructure In The '954 Patent Application

Section 112 unequivocally requires that "[t]he specification shall contain a written description of the invention." The '954 patent application fails to satisfy this written description requirement because the application contains *no* written description, express or inherent, of the claimed equiaxed microstructure.

As Kennecott concedes, the '954 patent application contains *no* express mention (description) of an equiaxed microstructure. *See* Opposition, at page i, first paragraph, lines 6-9. Thus, the claimed invention is *not* expressly described (*i.e., in ipsis verbis*) in the '954 patent application. *See In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978); Petition, at page 15, n.13.

The '954 patent application also fails to provide any "inherent" written description of an equiaxed microstructure since it is uncontroverted that *no one* reading the '954 patent application would or could know that a product formed as set out in the application has an equiaxed microstructure. That is, the '954 application contains *no* language whatsoever from which a skilled artisan can discern that a product formed will have an

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[1] In accordance with Rule 28.1 of the Rules of the Supreme Court, the parent companies, subsidiaries (other than wholly owned subsidiaries) and affiliates of Kyocera are set forth in the Petition, Appendix A at A1.

equiaxed microstructure. *See* Petition, Appendix D at D3, Finding 10; Appendix B at B4. In the words of the "inherent disclosure" cases, the application does *not* include any language whose "necessary and only reasonable construction" can be said to be the "legal equivalent" of the claimed "equiaxed microstructure" language. *Wagoner v. Barger*, 463 F.2d 1377, 1380 (CCPA 1972); Petition, at page 15, n.13 (discussing principles underlying what Kennecott refers to as the "inherent disclosure" cases). The existence of an equiaxed microstructure is *not* conveyed *in any way* to the reader of the patent application.[2]

This should be contrasted with a number of the "inherent disclosure" cases relied on by Kennecott. For example, in *In re Voss*, 557 F.2d 812, 818 (CCPA 1977), cited by Kennecott at pages 9 and 12 of the Opposition, the CCPA looked at all relevant evidence before concluding that a skilled artisan reading the patent specification would have understood the term "glass-ceramic material" used in the specification to mean a "crystal content . . . [of] at least 50% by weight" as set out in a patent claim:

> On this record, we conclude that the "at least 50%" limitation in appellant's claims merely quantifies the percentage crystallinity one of ordinary skill in the

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[2] Kennecott cites *In re Smythe*, 480 F.2d 1376, 1382 (CCPA 1973), for the statement that the invention can be conveyed "in any way." *See* Opposition, at page 9, second paragraph, lines 1-5. It is thus important to note that in *Smythe*, the CCPA held that the claimed limitation of "an 'inert fluid' would naturally occur to one skilled in the art *from reading appellants' description . . . of the segmentizing media specifically described*" in the patent specification. *Id.*, 480 F.2d at 1384 (emphasis added). The description *in the specification* would thus be understood by the skilled artisan *reading the specification* as encompassing the claimed "inert fluid" limitation. The "way" that the invention was conveyed was, as it must be under Section 112, by the description in the specification.

> art *at the time* would have attributed to the term "glass-ceramic material." *Id.*, 557 F.2d at 819 (emphasis in original).

The term "glass-ceramic material" was thus the "legal equivalent" of (or another way of referring to) the claimed "at least 50%" crystal content.

Kennecott argues that the '954 patent application should nonetheless be held to "inherently" contain a "written description of the invention [an equiaxed microstructure]" as Section 112 expressly requires, because the existence of an equiaxed microstructure, could be ascertained if one formed products by following the examples in the '954 patent application and then examined such samples under a microscope. *See* Opposition, at page 9, §A. But, as fully explained in the Petition, such a construction of Section 112 is contrary to the plain meaning of the statute, would frustrate the objectives of the statute (and of Section 102(b)), and is inconsistent with the spirit of this Court's decisions applying Section 112's predecessor statute as well as with precedent of the Federal Circuit.[3]

B. The Federal Circuit's Interpretation Of Section 112's Description Requirement *Is* Contrary To The Plain Meaning Of The Statute

Kennecott argues that requiring an invention to be described in a patent specification would be "to read a 'four corners' restriction into the express language of

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[3] Although in a very few pre-Federal Circuit cases, courts have departed from the plain meaning of the statute, the instant case is the first case in which the Federal Circuit has done so. *See e.g., Indiana General Corp. v. Lockheed Aircraft Corp.*, 408 F.2d 294 (9th Cir. 1968) (discussed by Kennecott in its Opposition at page 10). This Federal Circuit decision, if not overturned by this Court, would be binding precedent in *all* future cases in any and all jurisdictions. *South Corp. v. United States*, 690 F.2d 1368, 1369-71 (Fed. Cir. 1982).

§112." *See* Opposition, at page 8, second full paragraph, lines 4-6. To the contrary, however, such a restriction is explicitly stated in the statute which requires that:

> The *specification* shall contain *a written description of the invention* . . . (emphasis added).

It is Kennecott that seeks to read the "[t]he *specification* shall contain" (four corners) limitation out of the statute.[4] The plain meaning of the statute is that *the specification* must include a written description of the invention. Resort to matters outside the specification to identify and describe the invention is contrary to the statute's plain meaning.

C. Reversal By This Court Would Return The Description Requirement To Where It Was Before The Federal Circuit's Serious Departure In This Case From The Plain Meaning Of The Statute

Kennecott further argues that reversal of the Federal Circuit's decision below "would create chaos" by "the destruction of the doctrine of inherency." *See* Opposition, at page 18, §E. That statement is completely irresponsible and certainly wrong. Following the plain meaning of Section 112 by requiring that a patent specification contain a "written description of the invention" will only create order and predictability to guide all those persons desiring to file patent applications and/or evaluate patents and patent applications. Moreover, such a decision would be absolutely consistent with

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[4] Kennecott's citation to *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 65 L.Ed.2d 144, 149 (1980), to support its claim that matters outside the patent specification may be used to describe the invention under Section 112 is not understood. *See* Opposition at page 19, second paragraph, last six lines. *Chakrabarty* did not address that issue whatsoever.

the body of case law — existing before the Federal Circuit's serious departure in this case from the plain meaning of the statute — demonstrating that the "doctrine of inherency" is intended simply to allow applicants latitude and flexibility in selecting language for describing their invention. It was not intended to enable applicants to evade entirely Section 112's description requirement by failing to describe the claimed invention in any way (*i.e.*, either expressly or by language understood by the skilled artisan to refer to the claimed invention).

D. The Question Presented Herein *Is* Critical

Kennecott argues that the question presented herein is not important because "each description question turns on its own facts." *See* Opposition, at page 13, first paragraph, lines 1-2. That is like saying that fundamental constitutional rights are not important because each alleged violation of such a right turns on its own facts. *See Schlesinger v. Councilman*, 420 U.S. 738, 755, 43 L.Ed.2d 591, 607 (1975) ("The precise content of constitutional rights almost invariably turns on the context of fact and law in which they arise"). This Petition seeks a Writ to review the interpretation of Section 112's description requirement to guide *all* cases in which a skilled artisan cannot discern the invention from reading the patent specification. It is, as explained in the Petition, a critical issue which arises in a great number of contexts. *See* Petition, at pages 12-13, paragraph spanning both pages.

E. The Federal Circuit's Interpretation Of Section 112's Description Requirement *Is* In Conflict With (A) This Court's Decisions Applying Section 112's Predecessor Statute, And (B) The Federal Circuit's Own Precedent

Kennecott argues that the Federal Circuit's decision below is not in conflict with this Court's decision in *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 76 L.Ed. 163 (1931), because that case was decided under the statutory predecessor to Section 112 and the free zeolite bed was not inherent in the water softening apparatus. *See* Opposition, at page 14, second paragraph. That argument is devoid of merit. The description requirement of Section 112's predecessor, like the present Section 112, demanded that the patent specification contain a "written description" of the invention. *See* Petition, at page 10, n.10. The interpretation of this statutory language by this Court in *Permutit* is thus quite pertinent precedent for construing like language carried over into Section 112.[5] And the free zeolite bed, though possibly not inherent, was in fact explicitly shown in the drawings. But that was inadequate in *Permutit* because there still was no "written description" of the invention. The same remains true here as there is an entire absence of any mention or description of the claimed equiaxed microstructure in the '954 patent application.

Kennecott argues that the Federal Circuit's decision below is not in conflict with this Court's decision in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 83 L.Ed. 34 (1938), because the patent specification there stated that the webs were "extremely rigid" not "laterally flexible" as set out in the claims. *See* Opposition, at page 15, first paragraph. That argument is also meritless.

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[5] Section 112 has not been construed by this Court since the passage of the 1952 Patent Act, 35 U.S.C. Sections 1 *et seq.*

Kennecott admits (as it must) that the claimed lateral flexibility of the webs *was* an inherent property of the webs. *Id.* Nonetheless, that was insufficient as there was no description of that inherent property in the specification. The same is true here. "A sintered ceramic body . . . having a predominantly equiaxed microstructure" as set out in the claims of the '299 patent is *not* described by Kennecott in the much earlier '954 application which failed to refer to such microstructure either expressly or by implication.

Kennecott argues that the Federal Circuit's decision below is not in conflict with this Court's decision in *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 82 L.Ed. 1402, 1405 (1937), because in that case the description requirement was allegedly not an issue. *See* Opposition, at page 15, second paragraph. That is simply wrong. In *Wabash*, this Court assumed (*arguendo*) that the product claims could be refined by reference to the process in the specification (*i.e.*, that the claims could be read broadly so as to include anything in the written description of the process). This Court nonetheless found the claims defective, because the description of the process in the specification was silent as to the nature of the filament of the claimed product. 304 U.S. at 373, 82 L.Ed. at 1407-08. The same is true here. The description of the Kennecott process in the '954 patent application, like the description of the Kennecott product, is painfully silent as to the nature of the microstructure of the claimed ceramic body. There is thus no support in the '954 patent application for a "sintered ceramic body . . . having an equiaxed microstructure." The claims are defective here as they were in *Wabash*.

Kennecott argues that the Federal Circuit's decision below is not in conflict with its precedent, particularly, *Langer v. Kaufman*, 465 F.2d 915, 918 (CCPA 1972), because that case was an interference case concerning the issue of "constructive reduction to practice," the inventor

did not actually appreciate his claimed product invention at the time the patent application was filed, and the product of Run E in the patent specification could have had a diffraction pattern other than gamma (e.g., alpha). *See* Opposition, at page 16, first and second paragraphs. But that position is without rational basis.

The description requirement of Section 112 is the same no matter in what context it arises (interference, claim to priority of a U.S. patent, claim to priority of a foreign patent, etc.); it is precisely for the reason that it arises in so many contexts that it is so important.[6] Whether or not the inventor in *Langer* actually appreciated his invention at the time the application was filed was *not* even considered by the CCPA in determining whether the description requirement was met.[7] Finally, the ground for

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[6] Indeed, in its decision below, the Federal Circuit said that the standard followed in *Langer* "is consistent with that of the other cases on the issue of compliance with section 112, first paragraph." *See* Petition, Appendix B at B11, lines 4-14. Moreover, Kennecott's reference to "constructive reduction to practice" is disingenuous. Constructive reduction to practice of a particular invention occurs when an application is filed describing the invention *in accordance with the written description requirement (and other requirements) of Section 112.* Donald S. Chisum, *Patents*, Vol. 3, §10.05 at p. 10-74 (1987); *Hazeltine Corp. v. United States*, 820 F.2d 1190, 1196 (Fed. Cir. 1987) ("filing of a patent application is a constructive reduction to practice"). In *Langer*, there was no constructive reduction to practice because the specification did not describe the claimed invention *in accordance with the written description requirement of Section 112.* 465 F.2d at 917-19.

[7] To the contrary, it was considered by the CCPA in connection with its determination of whether prior to the filing of the patent application the product had been "actually reduced to practice." 465 F.2d at 919-20. Actual reduction to practice of an invention requires not only that a physical embodiment of the invention be constructed (*UMC Electronics Co. v. United States*, 816, F.2d 647, 652 (Fed. Cir. 1987), *cert. denied*, ___ U.S. ___, 108 S.Ct. 748, 98 L.Ed.2d 761 (1988)), but also that the inventor must appreciate the existence of the invention (*Heard v. Burton*, 333 F.2d 239, 243 (CCPA 1964)). That

the CCPA holding that the patent specification failed to meet the description requirement was *not* that Run E could in fact give a diffraction pattern other than gamma, since extrinsic evidence established that the form *was* in fact gamma. *Id.*, 465 F.2d at 920. Rather, the specification was defective because "*the '488 specification disclosure* does not necessarily lead to the conclusion that the Run E product was the gamma form." *Id.*, 465 F.2d at 918-19 (emphasis added). The same is true here. The'954 patent application does not mention, refer to, define, or describe the term "equiaxed microstructure." From a reading of the specification, it is impossible to discern whether the product has an equiaxed microstructure or some other microstructure. Therefore, the specification does not necessarily lead to the conclusion that the ceramic body will have an equiaxed microstructure.

F. The Federal Circuit's Decision Below Was Anything But "Fair"; It Was In Error And Should Be Reversed

Kennecott argues that the Federal Circuit's decision below was "fair." *See* Opposition, at page 17, §D. Nothing could be farther from the truth. It was Kennecott, not Kyocera, whose actions have resulted in the '299 patent being invalid under Section 102(b).[8] It would be fundamentally *unfair* to hold Kyocera subject to liability for alleged infringement of a patent which is

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completely separate issue, pertinent to the interference proceeding in *Heard* but not relevant here, was addressed by the CCPA *after* the CCPA had completed its analysis finding Section 112's description requirement not met. 465 F.2d at 917-19.

[8] Kennecott filed the '954 patent application on June 5, 1975, but deliberately delayed almost three years (until May 1, 1978) and more than one year after selling equiaxed products, to file another application (the '299 patent application) which mentioned for the very first time an equiaxed microstructure.

plainly invalid under Section 102(b), by torturing the language of Section 112 to sanction resort to the making and microscopic study of products to fulfill the statute's requirement that the patent "specification shall contain a written description of the invention."

G. Summary Of Reasons For Granting The Writ

In sum, Kennecott's Opposition presents nothing which detracts from the reasons stated in the Petition for issuing a Writ of Certiorari to review the judgment of the Federal Circuit. Section 112's description and other disclosure requirements, represent Congress' judgment as to the best means for ensuring the progress of science and the useful arts through the patent laws as expressed in the Constitution. The decision of the Federal Circuit, liberally construing the statute as allowing resort to matters outside the patent specification to identify and describe the invention, is contrary to the plain meaning of the statute which unequivocally states that "[t]he specification shall contain a written description of the invention." The decision is also inconsistent with the spirit of this Court's decisions applying Section 112's predecessor statute as well as with precedent of the Federal Circuit. Review by this Court is thus critical to provide necessary guidance as compliance with Section 112's description requirement is an issue which arises in a great number of contexts. Finally, review and reversal by this Court will terminate litigation over the '299 patent in the action below and in potential disputes with other parties.

CONCLUSION

For the reasons stated in the Petition and this Reply Brief, this Court should grant the Petition for Certiorari to review the judgment of the Federal Circuit.

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